

REMARKS

Claims 4-9, 13-16, 18, 24 and 25 are pending and rejected in this application. Claims 6, 7 and 24 are hereby amended.

Responsive to the rejection of claims 4-5, 13-16, and 18 under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 5,992,360 (Elendt, et al.), Applicants respectfully traverse.

Elendt, et al. discloses, a device wherein a "locking piston 16 loaded by the spring 15 is pushed back by the locking cap 18, so that the rocker arm 1 and the insert element 8 are no longer positively connected to each other." (*Column 3, lines 38-41*). (*Fig. 1*). Additionally, Elendt, et al. discloses, a rocker arm that "differs from that of FIG. 1 in that coupling means 13 are arranged at two points opposite each other". (*Column 4, lines 4-6*). (*Fig. 3*).

In contrast, Applicants' claims 4 and 13 recite in part, "a locking pin assembly selectively coupling together and decoupling said center post and said rocker arm, said locking pin assembly including an actuating pin, a second pin member and a middle pin member". (*Emphasis added*).

Applicants submit that the novel structure of the present invention is not anticipated by Elendt, et al. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, the identical invention must be shown in as complete detail as is contained in the ... claim.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920
(Fed. Cir. 1989).

The Examiner relies on Elendt, et al. to identify all of the limitations of Applicants' claims 4 and 13. However, Elendt, et al. fails to disclose a "locking pin assembly including an actuating pin, a second pin member and a middle pin member". More particularly, Elendt et al. discloses either a coupling means having a single locking pin 16 pushed back by a locking cap 18 (Fig.1), or a coupling means having a dual set of pins and caps opposite each other as shown in Fig.3. In contrast, Applicants' locking pin assembly, as recited in claims 4 and 13, is a three pin assembly.

Furthermore, the Applicants' single three pin locking assembly offers a significant advantage over the dual pin and cap assembly disclosed in Elendt, et al. More particularly, the Applicants' assembly requires only three pins to couple the center post to the rocker arm at two points. However, the locking assemblies, as disclosed in Elendt, et al., require an additional pin and an additional biasing spring to couple the center post to the rocker arm at two points. The Applicants' invention therefore offers a locking mechanism that is less expensive to produce and assemble, and more efficient.

For the foregoing reasons, Applicants respectfully submit that claims 4 and 13 are in condition for allowance which is hereby respectfully requested.

Furthermore, claim 5 is in condition for allowance because it depends from claim 4, which is in condition for allowance for the reasons given above.

Additionally, claims 14-16 and 18 are in condition for allowance because they

depend from claim 13, which is in condition for allowance for the reasons given above.

Applicants respectfully submit that claims 4-5, 13-16, and 18 are in condition for allowance which is hereby respectfully requested.

Responsive to the rejection of Claims 6-9 and 24-25 under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,992,360 (Elendt, et al.) in view of U.S. Patent No. 5,908,015 (Kreuter), Applicants have amended claims 6 and 24. Applicants hereby respectfully submit that amended claims 6-9 and 24-25 are now in condition for allowance.

Applicants have hereby amended claims 6 and 24 to include the limitation of "a locking pin assembly having an actuating pin, a second pin member and a middle pin member". Applicants respectfully submit that the amendments to claims 6 and 24 are disclosed in the application as originally filed and do not constitute new matter. Additionally, claim 7 is hereby amended to correct an antecedent error.

Elendt, et al. discloses, a device wherein a "locking piston 16 loaded by the spring 15 is pushed back by the locking cap 18, so that the rocker arm 1 and the insert element 8 are no longer positively connected to each other." (*Column 3, lines 38-41*). (*Fig.1*). Additionally, Elendt, et al. discloses, a rocker arm that "differs from that of FIG. 1 in that coupling means 13 are arranged at two points opposite each other". (*Column 4, lines 4-6*). (*Fig.3*).

In contrast, Applicants' amended claims 6 and 24 recite in part, " a locking pin assembly having an actuating pin, a second pin member and a middle pin

member selectively coupling together and decoupling said center post and said rocker arm ". (*Emphasis added*).

The Examiner relies on Elendt, et al. to identify the locking pin assembly of claims 6 and 24. However, Elendt, et al. fails to disclose a "locking pin assembly including an actuating pin, a second pin member and a middle pin member". More particularly, Elendt et al. discloses either a coupling means having a single locking pin 16 pushed back by a locking cap 18 (Fig.1), or a coupling means having a dual set of pins and caps opposite each other as shown in Fig.3. In contrast, Applicants' locking pin assembly, as recited in amended claims 6 and 24, is a three pin assembly.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Therefore, since Elendt et al. fails to teach or suggest the three pin locking assembly of amended claims 6 and 24, a *prima facie* case of obviousness has not been established.

For the foregoing reasons, Applicants respectfully submit that amended claims 6 and 24 are in condition for allowance, which is hereby respectfully requested.

Additionally, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1998). Therefore, claims 7-9 are in condition for allowance because they depend from amended claim 6, which is in condition for allowance for the reasons given above. Furthermore, claim 25 is in condition for allowance because it depends from amended claim 24, which is in condition for allowance for the reasons given above.

Applicants respectfully submit that claims 6-9 and 24-25 are in condition for allowance, which is hereby respectfully submitted.

Furthermore, Applicants respectfully submit that claims 7-9 are not unpatentable over U.S. Patent No. 5,992,360 (Elendt, et al.) in view of U.S. Patent No. 5,908,015 (Kreuter).

Kreuter discloses, a device wherein a "support plate or collet of the return spring 17 bears directly against a spherical projection of suitable configuration on the rocking lever 12, through which the thrust member of the valve clearance compensating element 16 can move." (*Column 6, lines 16-20*). (*Fig. 4*).

In contrast claim 7 recites in part, "said rocker arm includes elongate arms, said arms being one of attached to and integral with a body of said rocker arm and extending therefrom, said arms engaging one of said inner spring retainer and said outer spring retainer". (*Emphasis Added*).

The Examiner relies on Fig. 4 (reference item 12) of Kreuter to identify the elongate arms, extending from the rocker arm, and engaging one of said inner spring retainer and said outer spring retainer. However, Kreuter discloses a spherical projection on the rocking lever for communicating with the outer spring

retainer. Additionally, Kreuter does not disclose any portion of the rocker arm for engaging the inner spring retainer.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Therefore, since Kreuter fails to teach or suggest elongate arms extending from the rocker arm, engaging the inner and outer spring retainers, a *prima facie* case of obviousness has not been established.

For the foregoing reasons, Applicants respectfully submit that amended claim 7 is in condition for allowance, which is hereby respectfully requested.

Additionally, claims 8-9 are in condition for allowance because they depend from claim 7, which is in condition for allowance for the reasons given above.

Applicants respectfully submit that claims 7-9 are in condition for allowance, which is hereby respectfully submitted.

In the event Applicants have overlooked the payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefore and authorize that any charges be made to Deposit Account No. 10-0223.

Should you have any questions regarding the enclosed, please do not hesitate to contact me.

Respectfully submitted,

Dated: 9/23/03



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